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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,761	03/17/2000	Jason T. Murar	VEI0313PUS	5009

7590

07/08/2002

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EXAMINER

LEE, EDMUND H

ART UNIT PAPER NUMBER

1732

DATE MAILED: 07/08/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

MF 4

Office Action Summary

Application No.

09/528,761

Applicant(s)

MURAR ET AL.

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a method of making a component, classified in class 264, subclass 513.
 - II. Claim 19, drawn to a product by process, classified in class 428, subclass 545.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as performing the structural carrier and then bonding it to the decorative metal layer.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with D. Syrowik on 5/29/02 a provisional election was made without oral traverse to prosecute the invention of group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claim 19 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1 and 2-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 13-18 of copending Application No. 09/083943 (hereinafter '943) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). In regard to claim 1, '943 claims all of the instant claimed limitations except using a decorative layer of metal; and preventing the preform from moving in the mold cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, Ins 1-16). '943 and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of '943 in order to mold diverse plastic components having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). '943 and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of '943 to have vacuum holes to hold the decorative layer of '943 against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process. In regard to claims 2-7, '943 claims all the limitations.

This is a provisional obviousness-type double patenting rejection.

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8. Claim 8 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 09/083943 (hereinafter '943) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). '943 claims all of the instant claimed limitations except using a decorative layer of metal; and preventing the preform from moving in the mold cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, lns 1-16). '943 and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of '943 in order to mold diverse plastic components having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). '943 and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of '943 to have vacuum holes to hold the decorative layer of '943 against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process.

This is a provisional obviousness-type double patenting rejection.

9. Claims 9-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-18 of copending Application No. 09/083943 (hereinafter '943) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). In regard to claim 9, '943 claims all of the instant claimed limitations except using a decorative layer of metal; and preventing the preform from moving in the mold cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, lns 1-16). '943 and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of '943 in order to mold diverse plastic components having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). '943 and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of '943 to have vacuum holes to hold the decorative layer of '943 against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process. In regard to claims 10-16, '943 claims all the limitations.

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This is a provisional obviousness-type double patenting rejection.

10. Claims 17-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-20 of copending Application No. 09/083943 (hereinafter '943) in view of Smith (USPN 6187233). In regard to claim 17, '943 claims all of the instant claimed limitations except using a decorative layer of metal. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, lns 1-16). '943 and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of '943 in order to mold diverse plastic components having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). '943 and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of '943 to have vacuum holes to hold the decorative layer of '943 against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process. In regard to claim 18, '943 claims all the limitations.

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This is a provisional obviousness-type double patenting rejection.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preisler et al (USPN 6082762) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). In regard to claim 1, Preisler et al teach the basic claimed process including a method of making a molded plastic component (fig 6); providing a film sheet, the film sheet being selected from the group consisting of polyester, polyurethane, and polycarbonate (col 4, ln 5-15); forming the film into a preform (fig 6); placing the preform in a mold cavity of an injection mold having a shape defining the desired plastic component (col 3, lns 1-25; fig 6); and injecting a thermoplastic elastomer into the mold cavity to generate a structural carrier for the preform, the generation creating sufficient pressure and heat to bond the structural carrier to a bottom surface of the preform to form the molded plastic component (col 3, lns 1-25; fig 6). However, Preisler et al does not teach using a decorative layer of metal; and preventing the preform from moving in the mold cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, lns 1-16). Preisler et al and Smith are combinable because they are analogous with respect to

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injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of Preisler et al in order to mold diverse plastic components having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). Preisler et al and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of Preisler et al to have vacuum holes to hold the decorative layer of Preisler et al against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process. In regard to claims 2-7, Preisler et al teach the claimed elastomer (col 4, lns 30-40); cutting the preform prior to the step of placing (fig 6); the flex modulus of the structural carrier (col 4, lns 50-55); the shore D of the carrier (col 4, lns 45-55); and the thickness of the film sheet (col 4, lns 44-46). However, Preisler et al does not teach the injection parameters. Injection temperature and pressure are well-known in the molding art as important molding parameters and the desired temperature and pressure would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, claimed temperature and pressure are generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time

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the invention was made to set the injection molding temperature and pressure of Preisler et al to the claimed values in order to efficiently produce high quality molded components.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Preisler et al (USPN 6082762) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). In regard to claim 8, Preisler et al teach the basic claimed process including a method of making a molded automotive plastic component (fig 6); providing a film sheet, the film sheet being selected from the group consisting of polyester, polyurethane, and polycarbonate (col 4, ln 5-15); forming the film into a preform (fig 6); placing the preform in a mold cavity of an injection mold having a shape defining the desired plastic component (col 3, lns 1-25; fig 6); and injecting a thermoplastic elastomer into the mold cavity to generate a structural carrier for the preform, the generation creating sufficient pressure and heat to bond the structural carrier to a bottom surface of the preform to form the molded plastic component (col 3, lns 1-25; fig 6). However, Preisler et al does not teach using a decorative layer of metal; and preventing the preform from moving in the mold cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, lns 1-16). Preisler et al and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of Preisler et al in order to mold diverse plastic components

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having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). Preisler et al and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of Preisler et al to have vacuum holes to hold the decorative layer of Preisler et al against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process.

14. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preisler et al (USPN 6082762) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). In regard to claim 9, Preisler et al teach the basic claimed process including a method of making a molded plastic component (fig 6); providing a film sheet, the film sheet being selected from the group consisting of polyester, polyurethane, and polycarbonate (col 4, lns 5-15); forming the film into a preform (fig 6); placing the preform in a mold cavity of an injection mold having a shape defining the desired plastic component (col 3, lns 1-25; fig 6); and injecting a thermoplastic elastomer into the mold cavity to generate a structural carrier for the preform, the generation creating sufficient pressure and heat to bond the structural carrier to a bottom surface of the preform to form the molded plastic component wherein the film is coated with a PVDF and clear plastic layer (col 3, lns 1-25; col 4, 35-45; fig 6). However, Preisler et al does not teach using a decorative layer of metal; and preventing the preform from moving in the mold

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cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers thereon (col 14, lns 1-16). Preisler et al and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of Preisler et al in order to mold diverse plastic components having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). Preisler et al and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of Preisler et al to have vacuum holes to hold the decorative layer of Preisler et al against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process. In regard to claims 10-16, Preisler et al teach setting the PVDF to be more than 50% of the total thickness of the preform (col 4, lns 40-47); the claimed elastomer (col 4, lns 30-40); cutting the preform prior to the step of placing (fig 6); the flex modulus of the structural carrier (col 4, lns 50-55); the shore D of the carrier (col 4, lns 45-55); and the thickness of the film sheet (col 4, lns 44-46). However, Preisler et al does not teach the injection parameters. Injection temperature and pressure are well-known in the molding art as important molding parameters and the

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desired temperature and pressure would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, claimed temperature and pressure are generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the injection molding temperature and pressure of Preisler et al to the claimed values in order to efficiently produce high quality molded components.

15. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preisler et al (USPN 6082762) in view of Smith (USPN 6187233) and Nakamura et al (USPN 5614146). In regard to claim 17, Preisler et al teach the basic claimed process including a method of making an molded plastic automotive component (fig 6); providing a film sheet, the film sheet being selected from the group consisting of polyester, polyurethane, and polycarbonate (col 4, ln 5-15); forming the film into a preform (fig 6); placing the preform in a mold cavity of an injection mold having a shape defining the desired plastic component (col 3, lns 1-25; fig 6); and injecting a thermoplastic elastomer into the mold cavity to generate a structural carrier for the preform, the generation creating sufficient pressure and heat to bond the structural carrier to a bottom surface of the preform to form the molded plastic component wherein the film is coated with a PVDF and clear plastic layer (col 3, lns 1-25; col 4, 35-45; fig 6).

However, Preisler et al does not teach using a decorative layer of metal; and preventing the preform from moving in the mold cavity during the step of injecting. Smith teaches injection molding a plastic component having decorative metal and clear coat layers

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thereon (col 14, Ins 1-16). Preisler et al and Smith are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a decorative metal layer as taught by Smith into the process of Preisler et al in order to mold diverse plastic components⁶ having great aesthetic appeal. Nakamura et al teach injection molding a container having a decorative label thereon (figs 1, 6, and 8); and preventing movement of the label against the inner surface of the female mold by vacuum (fig 7). Preisler et al and Nakamura et al are combinable because they are analogous with respect to injection molding a plastic component having a decorative layer/label thereon. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold of Preisler et al to have vacuum holes to hold the decorative layer of Preisler et al against the mold surface as taught by Nakamura et al in order to ensure proper position of the layer during the injection molding process. In regard to claim 18, Preisler et al teach setting the PVDF to be more than 50% of the total thickness of the preform (col 4, Ins 40-47).

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 98/51516 teach using a decorative metal layer against a PVDF layer.

17. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Edmund Lee whose telephone number is (703) 305-4019. The examiner can normally be reached on Monday-Wednesday and

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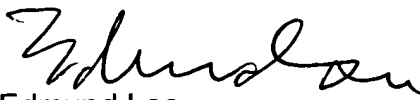
Friday from 8:00 AM to 4:00 PM. The fax number for Examiner Edmund Lee is (703) 872-9615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703) 308-3829.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

EHL

June 30, 2002


Edmund Lee 6/30/02
Patent Examiner, AU 1732